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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,625	11/02/2001	Gerardo Castillo	PROTEO.P18	5292

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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT PAPER NUMBER

1654

DATE MAILED: 01/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,625

Applicant(s)

Castillo et al.

Examiner

Christopher Tate

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18 and 22, drawn to a method of isolating compounds/components that possess amyloid inhibitory activity from *Uncaria* plant matter, classified in class 424, subclass 769, for example.
- II. Claim 19, drawn to a composition referred to as PTI-777, classified in class 424, subclass 725+, for example.
- III. Claims 20-21, drawn to a composition referred to as PTI-777 fraction, classified in class 424, subclass 725+.
- IV. Claim 23, drawn to a composition referred to as compound H, unclassifiable.
- V. Claims 24-30, drawn to a method of treating amyloidosis, a disease related to alpha-synuclein, or amyloid fibril formation, classified in class 424, subclass 725+.
- VI. Claims 31 and 33-38, drawn to a plant material, classified in class 424, subclass 725+.
- VII. Claims 32-38, drawn to a pharmaceutical composition comprising chlorogenic acid and epicatechin, classified in class 5154, subclass 183, for example.

The inventions are distinct, each from the other because of the following reasons:

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The compositions of Groups II-IV, VI, and VII are distinct, each from the other. The composition of Group II is not a fractionated whereas the composition of Group III is. The composition of Group IV contains "compound H" which is not recited in the other composition groups. The composition of Group VI contains a material which is not required of the other composition groups. The composition of Group VII contains two defined compounds which is not required of the other composition groups. The methods of Groups I and V are not related as one is drawn a method of making *Uncaria* compounds/components (Group I) and one is drawn to a therapeutic method of use (Group V).

In addition, with respect to Groups II, III, and V-VII, this application contains claims directed to the following patentably distinct species of the claimed invention:

The various claimed (PTI-777) fractions or unfractionated PTI-777 - e.g., as recited in claims 19, 20, 21, 25.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (elect one of the recited fractions or unfractionated PTI-777) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 19, 20, 24, 25, 29, 31, and 33 are generic.


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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (703) 305-7114. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached at (703) 306-3220. The Group receptionist may be reached at (703) 308-0196. The fax number for art unit 1654 is (703) 872-9306.



Christopher R. Tate
Primary Examiner, Group 1654